

REMARKS

Claims 19 and 29 have been amended to overcome the Examiner's objection for claim informalities.

Claims 1-30 were rejected as anticipated by U.S. Patent No. 5,609,827 (Russell et al.) "Russell". This rejection is respectfully traversed. A patent claim is anticipated only if each and every element of the claim is present in a single prior art reference. Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989 (Fed. Cir. 2000). First, Russell cannot anticipate Claim 1 when it lacks disclosure of the claimed excised tissue held in compression. Russell's container provides compartments for specimens, but fails to show such specimen being held in compression. Second, Claim 1 describes an image of the tissue specimen suitable for pathological examination, whereas Russell's container is for only providing radiological images. Radiology and pathology are different medical specialties. Radiology is the transmittance of high energy x-rays to provide image on film which are shadows through a specimen. In contrast, pathology deals with analysis of cellular and/or structure organization of tissue, and as such requires the capability of imaging at microscopic resolutions. Russell supports this at column 2, lines 43-47, stating "[a]fter completion of the x-ray analysis, the lid may be removed and a preservative, commonly formalin, may be placed in the container to fix the tissue samples in a manner leading to further pathological and microscopic examination." Clearly, Russell itself shows that his x-ray analysis is not comparable to pathological examination, for if it were, he would not have stated that such tissue once fixed would need further pathological and microscopic examination. Accordingly, Russell fails to disclose an image suitable for pathological application. Third, Russell fails to disclose the scanning means of Claim 1 for providing such an image suitable for pathological application. It is the Examiner's position that x-ray imaging of the Russell container to provide a radiograph describes the claimed scanning means. However, x-ray imaging cannot represent the scanning means where the radiograph would not be an image suitable for pathological application, otherwise, why would Russell state that pathological and microscopic examination is performed after completion of the x-ray analysis at column 2, lines 43-47. Clearly, Russell fails to disclose each and every element of Claim 1, and withdrawal of the rejection is requested. Further, Claim 15 depends on base Claim 1, and thus not anticipated by Russell.

Claims 2 and 5 also cannot be anticipated by Russell where Russell does not disclose a confocal imaging system. Russell discloses only radiological imaging of its

container, and radiological imaging is not the same, or even comparable, to confocal imaging. For example, confocal imaging can produce images which are microscopic in resolution, while radiological imaging cannot.

Claims 3, 4, and 6 describe a stage which may be used with the holder of Claim 1 for moving the holder. Russell's figures show a container without any stage. Moreover, no stage is needed since the entire container can be radiographically imaged at the same time (see column 2, lines 34-47).

Claim 7 further describes the holder of Claim 1 as a trocar. No figures or description in Russell shows its container as being a trocar to support anticipation of Claim 7.

Claims 8-12, and 30 describe the holder of Claim 1 as a shell and the scanning means of Claim 1 as further comprising means for rotating the shell and means for translating the shell. No such rotating means or translating means is disclosed anywhere in Russell. Moreover, no rotating means or translating means is needed since the entire container can be radiographically imaged at the same time (see column 2, lines 34-47).

Claims 13-14 describe the path of a scan provided by the scanning means of Claim 1 as being helical. Russell discloses no helical path for its container.

Claim 16 describes an encoder coupled to the holder of Claim 1. No encoder is disclosed in Russell for providing signals correlated positionally with a scanning means.

Claim 17 describes the holder of Claim 1 as a cassette of material substantially free of bi-refrindex, and Claim 18 describes that material as being amorphous polyolefin. Russell's material specifications at column 5, lines 11-15, neither discloses that its container is of material substantially free of bi-refrindex, nor that it is of amorphous polyolefin material.

Claim 23 describes the imaging system of Claim 1 as being operative in accordance with one of optical coherence tomography or two-photon microscopy. Russell only discloses its imaging as radiological, and thus cannot anticipate imaging by optical coherence tomography or two-photon microscopy. Thus, Russell also fails to disclose each and every element of Claims 2-14, 16-18, 23, and 30, and Applicants request withdrawal of the rejection of these claims.

Claim 19 describes a method for imaging surgical biopsies, and for reasons argued with respect to Claim 1, Claim 19 also cannot be anticipated by Russell where Russell fails to disclose any specimen under compression or any image for pathological examination of the specimen. Claims 20-22 depend on Claim 19. Claim 20 describes the

step of making an incision with a trocar which provides the cassette. No such step is disclosed in Russell as Russell shows no trocar for making any incision. Claim 21 describes rotating and translating the cassette with respect to a head of an imaging system to carry out the imaging step of Claim 19. No such rotating or translating of its container is shown in Russell, as argued earlier in connection with Claims 8-12 and 30. Accordingly, Applicants do not believe that Claims 19-22 are anticipated by Russell, and request that the rejection of these claims be withdrawn.

Claim 24 describes a system for imaging a tissue sample having means for scanning a cassette to provide at least one image of the tissue sample suitable for pathological examination. For reasons argued with respect to Claim 1, no scanning means is disclosed in Russell for providing any image of a tissue sample suitable for pathological examination. Claims 25-27 depend on Claim 24. Claim 25 describes means for moving the cassette with respect to the scanning means. No such moving means of its container is shown in Russell. Claim 26 describes its cassette as of a material optically transparent to the scanning system of Claim 24. However, Russell's container 10 is not optically transparent since the bottom (16) of the container is covered by a circular support sheet or pad (24) of absorbent material, preferably made of suitable paper (see column 4 at lines 9-11). Paper is typically opaque and thus not optically transparent. Claim 27 describes the scanning means of Claim 24 as being operative by one of confocal microscopy, optical coherence tomography, or two-photon microscopy. None of these imaging modalities is anticipated by radiological imaging. Thus, Claims 24-27 are not anticipated by Russell, and Applicants request withdrawal of the rejection of these claims.

Claim 28 describes an apparatus for enabling imaging of tissue having a stage which presents the tissue in the cassette to an optical imaging system and means for moving the cassette along a path to enable microscopic imaging of the tissue in the cassette. For reasons argued earlier, Russell fails to disclose a stage to present the tissue in its container, an optical imaging system, or means for moving its container along a path with respect to the optical imaging system to enable microscopic imaging of tissue. Thus each and every element of Claim 28 is not present in Russell, and Russell cannot anticipate this claim.

Claim 29 describes a cassette wherein the chamber may be made of substantially optically transparent material. For reasons argued with respect to Claim 26 the biopsy container is not substantially optically transparent since it includes material, i.e., paper

along the container bottom. Thus, neither Claims 28, nor 29 are anticipated by Russell, and withdrawal of the rejection of these claims is requested.

It is believed the application is in condition for allowance. A petition for a three-month extension of time is enclosed with authorization to charge a deposit account for \$475.00.00 to cover the petition fee.

Dated: February 2, 2004

Respectfully submitted,



Kenneth J. LuKacher
Attorney for Applicant(s)
Registration No. 38,539

South Winton Court
3136 Winton Road South, Suite 204
Rochester, New York 14623
Telephone: (585) 424-2670
Facsimile: (585) 424-6196

Enclosures: Petition for Extension of Time;
Two Certificates of Mailing by Express Mail, Express Mail No.
EV325176559US; and
Claim List.